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| 10/806,267 | 03/23/2004 | Takashi Ohno | KKP-0276 | 1916 |
| 23353 7590 03/23/2007 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036 | | | EXAMINER SHOSHO, CALLIE E | |
| | | | ART UNIT 1714 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/806,267

Applicant(s)

OHNO, TAKASHI

Examiner

Callie E. Shosho

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-14.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Callie E. Shosho
Primary Examiner
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Attachment to Advisory Action

1. Applicant's amendment filed 3/7/07 has been fully considered but the amendment has not been entered given that the amendment raises new issues that would require further consideration and search.

The amendment raises new issues that would require further consideration under 35 USC 112, first paragraph. Specifically, claim 1 has been amended to recite "a solvent consisting essentially of a water and an alcoholic solvent, said solvent having a vapor pressure at 20 °C of 0.5 kPa or higher". It is the examiner's position that this phrase fails to satisfy the written description requirement under 35 USC 112, first paragraph since there does not appear to be a written description requirement of the phrase in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed. It is noted that while there is support in the specification as originally filed to recite that the alcoholic solvent has a vapor pressure at 20 °C of 0.5 kPa or higher, there is no support in the specification to recite that the solvent, which includes solvents other than alcoholic solvent, has a vapor pressure at 20 C of 0.5 kPa or higher.

The amendment also raises new issues under 37 CFR 1.75(c) given that claim 5 is of improper dependent form for failing to further limit the subject matter of a previous claim. Specifically, claim 5, which depends on claim 1, recites "the solvent formed by a water and the alcoholic solvent" while claim 1 has been amended to recite "a solvent consisting essentially of a water and an alcoholic solvent". Thus, claim 5 fails to further limit the scope of the claim on which it depends, namely claim 1, given that claim 5 is broader than claim 1. That is, while

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claim 1 is limited to solvent “consisting essentially of” water and alcoholic solvent, claim 5 discloses solvent “formed by” water and alcoholic solvent.

The amendment also raises new issues that would require further consideration and search given that claim 1 has been amended to delete the recitation of “a wetting regulating agent”. Such amendment broadens the scope of the claim with respect to the ink given that while previously the claims, as well as the prior art applied against the claims, were required to have such wetting regulating agent, now, no such limitation is required. New searches would therefore be required given that now the claim encompasses ink that does not require wetting agent.

Further, the amendment also raises new issues that would require further consideration and search given that claim 1 has been amended to recite “solvent consisting essentially of a water and an alcoholic solvent”. The use of “consisting essentially of” narrows the scope of the claims with respect to the solvent. Such narrowing of the scope of the claims would require further consideration and search.

It is noted that even *if* the amendment were entered, while the amendment would overcome the 35 USC 112, 1st paragraph rejections of record and the rejection of record utilizing Allison et al. (U.S. 6,160,034) as set forth in paragraph 11 of the office action mailed 12/7/06, Ota et al. (U.S. 6,916,862) would remain a relevant reference against the present claims.

Applicant argues that there is no disclosure or suggestion in Ota et al. of the combination of ball-point pen and ink as presently claimed.

However, it is noted that Ota et al. disclose ink wherein the ink comprises water, pigment, alcoholic solvent, and acrylic resin wherein the ink has viscosity less than 10 cP.

Further, Ota et al. disclose the use of ball-point pen comprising the ink. While it is agreed that there is no disclosure in Ota et al. of specific pen, this is why Ota et al. is combined with Kobayashi et al. (U.S. 5,678,942) that discloses ball-point pen as presently claimed in order to prevent ink flow out and scratchy writing.

Applicant argues that there is no suggestion in Ota et al. that a ball-point pen might be utilized for inks on glossy film.

However, firstly, it is noted that only present claim 11 requires using the ball-point pen to write on non-permeable writing surface. Further, attention is drawn to col.3, lines 44-46 of Ota et al. that discloses that an object of the invention is to provide ink that is used for various purposes including ball-point pen, col.6, lines 62-64 that disclose utilizing the ink on glossy paper or film, i.e. non-permeable wiring surface, and to col.30, lines 18-22 that discloses that the acrylic resin is utilized in order to obtain fixability on such glossy mediums.

Thus, given that Ota et al. disclose the ink is for ball-point pen, given that it is disclosed that the inks are formulated so as to be able to be printed on glossy medium (i.e. acrylic resin), and given that Ota et al. disclose utilizing the ink on glossy paper or film, it is the examiner's position that that Ota et al. do disclose ball-point pen utilized on non-permeable writing surface as presently claimed.

Applicant argues that Ota et al. and Hattori et al. (U.S. 2005/0096410) are not relevant references against the present claims given that there is no disclosure in either reference of a solvent comprising water and alcohol.

However, firstly, with respect to Hattori et al., it is noted that this reference is a teaching reference only utilized for its disclosure that ethanol, propanol, and butanol, disclosed by Ota et al., possess vapor pressure as presently claimed. Thus, while Hattori et al. do not disclose all the features of the present claimed invention, Hattori et al. is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, and in combination with the primary reference, discloses the presently claimed invention.

With respect to Ota et al., it is noted that Ota et al. disclose ink that comprises both alcohol solvent and water (col.12, lines 22-25 and col.25, lines 53-57).

Applicant also argues that even if a *prima facie* case of obviousness has been shown, the showing is rebutted by the demonstration of unexpected and surprising results exhibited by applicants' invention

While applicant does not specifically discuss the unexpected and surprising results exhibited by their invention, it is assumed that applicant is referring to the comparative data set forth in the present specification with respect to the solvent.


However, it is the examiner's position that the data is not successful in establishing unexpected and surprising results over the prior art given that there is not proper side-by-side comparison between the inventive inks and the comparative inks.

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The data compares ink within the scope of the present claims, i.e. comprising water and alcoholic solvent having vapor pressure of 0.5 kPa or higher (examples 1-7), with ink outside the scope of the scope of the present claim, i.e. comprising water but not comprising alcoholic solvent having vapor pressure of 0.5 kPa or higher (comparative examples 3 and 7). It is shown that the presently claimed ink is superior in terms of writing ability, fixing, drying, covering power, blotting, and/or drying at pen tip.

However, there is not proper side-by-side comparison between the inventive inks and the comparative inks. For instance, the closest comparison with comparative inks 3 and 7 appears to be inventive inks 7 or 9. However, the inks comprise different amounts of water and/or alcohol solvent, comparative inks utilize wetting agent not required in inventive ink 9, inventive ink 7 comprises no fixing agent which is required in the comparative inks, and comparative ink 7 requires 2% fixing resin while inventive ink 9 requires only 0.8% fixing resin. Thus, it is not clear if the differences between the inks are due to the different amounts of solvent, wetting regulating agent, and fixing agent utilized or to the use of alcohol solvent having vapor pressure as presently claimed.

In light of the above, it is the examiner's position that the data is not successful in establishing unexpected or surprising results over the cited prior art.



Callie E. Shosho
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